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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,825	05/22/2001	Satoru Ueda	7217/64562	8871
7590	01/26/2005			EXAMINER
COOPER & DUNHAM LLP 1185 Avenue of the Americas New York, NY 10036			YIGDALL, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/862,825	UEDA, SATORU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael J. Yigdall	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 September 2004.  
 2a) This action is **FINAL**.                                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-5,7 and 10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3-5,7 and 10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Applicant's response and amendment filed on September 24, 2004 has been fully considered. Claims 1, 3-5, 7 and 10 are now pending.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive.
3. Applicant contends that the combination of Reeder and Oshima fails to show or suggest a database for storing individual information of a user, a plurality of supplemental pay functions, purchased counts and used counts, and charging a fee for adding purchased counts for accessing a selected one of the plurality of supplemental pay functions. Likewise, Applicant suggests that Reeder merely charges a user for the use of a program (Applicant's remarks, pages 8-9).

However, Reeder also discloses charging an additional fee for the use of particular features or functions (see, for example, column 9, lines 25-27 and column 10, lines 17-27). Accordingly, these functions are considered to be supplemental pay functions. Reeder increments a message number each time a supplemental pay function is purchased (see, for example, column 10, lines 31-34), and thus the message number represents a purchased count. Similarly, Reeder records each use of the feature or function (see, for example, page 11, line 31 to page 12, line 14), which is to say Reeder records a used count.

See the claim rejections below.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Pub. No. WO 97/14085 to Reeder (art of record, "Reeder") in view of U.S. Pat. No. 6,081,785 to Oshima et al. (art of record, "Oshima").

With respect to claim 1 (currently amended), Reeder discloses a software program providing system for providing and managing access to a software program (see, for example, FIG. 1 and page 3, lines 11-15), comprising:

- (a) a storage medium for storing said software program and an individual identification code for identifying said storage medium (see, for example, store 150 in FIG. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium);
- (b) a user terminal for installing said storage medium therein and for accessing said software program stored in said storage medium (see, for example, apparatus 100 in FIG. 1, and page 3, lines 11-15 and line 32 to page 4, line 6, which shows a personal computer or user terminal having a storage medium installed therein for storing and accessing software programs; also see, for example, page 5, lines 10-14, which shows obtaining the software program and storing it in the storage medium);
- (c) database management means for storing a database including individual information of a user, information regarding a range of access limitations to said software program, and information regarding a condition of access to said software program, wherein said database is

searched using said individual identification code as a search key (see, for example, code data 230 and bill log 240 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code), wherein said information regarding said range of access limitations includes a plurality of supplemental pay functions and said information regarding said condition of access includes purchased counts and used counts (see, for example, page 10, lines 17-27, which shows a plurality of supplemental pay features or functions; also see, for example, page 11, lines 8-19, which shows a condition of access for the feature or function based on a message number, and page 10, lines 31-34, which shows that the message number is incremented when a feature or function is purchased and thus represents a purchased count; also see, for example, page 11, line 31 to page 12, line 14, which shows recording each use of the feature or function, i.e. as a used count), and

    said database management means further comprises fee charging means for charging a fee for adding purchased counts to access a selected one of said plurality of supplemental pay functions (see, for example, page 9, lines 25-27, which shows fee charging means for charging a fee to access the supplemental pay functions; also see, for example, page 13, lines 7-15, which shows that access to the functions may be prepaid); and

    (d) information communication means for connecting said database management means with said user terminal (see, for example, communications link 10 and network 20 in FIG. 1, and page 3, lines 21-31), wherein

    said software program providing system authorizes said user terminal to access said software program stored in said storage medium based on said information regarding said range

of access limitations (see, for example, page 7, lines 30-37), said information regarding said condition of access to said software program, and said information searched using said individual identification code as said search key (see, for example, page 6, line 37 to page 7, line 5), said database management means reading said individual identification code from said storage medium installed in said user terminal through said information communication means (see, for example, page 10, lines 6-17, which shows reading a identification code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions).

Reeder does not expressly disclose limitation wherein said storage medium is a removable storage medium.

However, Oshima discloses a system for providing and managing access to a software program stored with an identification code on a removable, optical storage medium, wherein the software is installed on a user terminal from the removable storage medium, for the purpose of preventing illegal copying of the software (see, for example, column 10, lines 15-54; also see, for example, FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 3 (previously presented), Reeder also discloses the limitation wherein said information communication means further comprises ciphering means for ciphering

communication between said database and said user terminal (see, for example, page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 4 (original), although Reeder discloses the use of encryption to provide additional security (see, for example, page 5, line 33 to page 6, line 1), Reeder does not expressly disclose the limitation wherein said storage means further comprises a DVD-ROM and said individual identification code includes a BCA code recorded through a laser beam during a fabrication process of said individual identification code.

However, Oshima further discloses the use of the BCA to store an identification code and a cryptographic key (see, for example, column 1, lines 36-50) on a DVD (see, for example, column 3, lines 63-67), so that a fee may be charged for the use of the disk (see, for example, column 4, lines 60-64). Oshima further discloses that the BCA code is recorded with a laser during fabrication and can be used for security (see, for example, column 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to use a DVD-ROM storage medium with a BCA identification code, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to improve security by transcribing the storage medium with an individual identification code.

With respect to claim 5 (currently amended), Reeder discloses a software program providing method for providing and managing access to a software program (see, for example, FIG. 1 and page 3, lines 11-15), comprising the following steps of:

(a) storing said software program in a storage medium along with an individual identification code for identifying said storage medium (see, for example, store 150 in FIG. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium);

(b) storing into a database, information regarding individual information of a user, information regarding a range of access limitations to said software program, and information regarding a condition of access to said software program, wherein said database is searched using said individual identification code as a search key (see, for example, code data 230 and bill log 240 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code), and said information regarding said range of access limitations includes a plurality of supplemental pay functions and said information regarding said condition of access includes purchased counts and used counts (see, for example, page 10, lines 17-27, which shows a plurality of supplemental pay features or functions; also see, for example, page 11, lines 8-19, which shows a condition of access for the feature or function based on a message number, and page 10, lines 31-34, which shows that the message number is incremented when a feature or function is purchased and thus represents a purchased count; also see, for example, page 11, line 31 to page 12, line 14, which shows recording each use of the feature or function, i.e. as a used count);

(c) charging a fee for adding purchased counts to access a selected one of said plurality of supplemental pay functions (see, for example, page 9, lines 25-27, which shows fee charging

means for charging a fee to access the supplemental pay functions; also see, for example, page 13, lines 7-15, which shows that access to the functions may be prepaid);

(d) communicating between a user terminal having said storage medium installed therein and a database management means managing said database (see, for example, communications link 10 and network 20 in FIG. 1, and page 3, lines 21-31),

wherein said communicating is done when said user accesses said software program stored in said storage medium installed in said user terminal (see, for example, page 5, lines 18-25, which shows initiating a transmission when the user accesses the software program); and

(d) authorizing said user terminal to access said software program based on said information regarding said range of access limitations (see, for example, page 7, lines 30-37), said information regarding said access condition to said software program, and said information searched from said database based on said individual identification code (see, for example, page 6, line 37 to page 7, line 5), wherein said individual identification code is read out from said storage medium installed in said user terminal (see, for example, page 10, lines 6-17, which shows reading a identification code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions).

Reeder does not expressly disclose limitation wherein said storage medium is a removable storage medium.

However, Oshima discloses a system for providing and managing access to a software program stored with an identification code on a removable, optical storage medium, wherein the software is installed on a user terminal from the removable storage medium, for the purpose of

preventing illegal copying of the software (see, for example, column 10, lines 15-54; also see, for example, FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 7 (original), Reeder also discloses the limitation wherein said communicating step further comprises the step of ciphering communication between said user terminal and said database management means (see, for example, page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 10 (new), the claim recites a software program providing system that corresponds to the software program providing system recited in claim 1 (therefore, see Reeder and Oshima as applied to claim 1 above).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael J. Yigdall  
Examiner  
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SUPERVISORY PATENT EXAMINER